

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Uckun Examiner: R. Travers  
Serial No.: 09/272821 Group Art Unit: 1617  
Filed: March 20, 1999 Docket No.: 12152.55US01  
Title: NNI FOR TREATMENT OF MULTI-DRUG RESISTANT HIV

CERTIFICATE UNDER 37 CFR 1.10:

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By: \_\_\_\_\_

Name: John Junkers

REPLY BRIEF

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria VA 22313-1450

Sir:

The Appellant has received and reviewed the Examiner's Answer mailed on May 24, 2004. The Appellant offers the following reply and reserves the right to present further argument at an oral hearing, which Appellant has concurrently requested, and paid the required fee for.

The Examiner asserts at page 11, second paragraph of the Examiner's Answer that "to practice the invention as claimed, and envisioned, the skilled artisan must in every case check the suspected etiological agent against all conventional anti-HIV agents to access the resistance profile. This requirement, absent guidance as to how the resistance profile can be easily deduced, forces the skilled artisan to engage in experimentation in every instance the invention is practiced: impermissible under current patent law." The Appellant does not agree with this

statement and respectfully asserts that even the Examiner himself did not, in the very recent past, agree with this statement.

In the September 21, 2001 office action (Paper No. 14), the Examiner noted an alternative and well-known way of identifying the presence of a resistant strain of HIV when he asserted that one of skill in the art would have been motivated to modify Lind because a physician could identify a patient harboring a resistant strain by the mere fact that the patient is not responding to anti-HIV chemotherapy (Paper No. 14 at p. 3). Appellant respectfully disagrees that this would rise to the level of undue experimentation as admonished by the court in *In re Wands*.

With regard to the Examiner's comments about the unexpected results shown by the Appellant, the Appellant notes, with respect to the Examiner's statement that evidence must be "of a scope reasonably commensurate with the scope of the subject matter claimed" (Examiner's Answer page 13, second paragraph), that the Appellant has presented data regarding the only two compounds claimed. Appellant does not understand how the data could be any more commensurate with the scope of the claimed subject matter than it currently is.

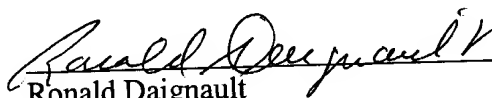
Appellant also takes issue with the Examiner's assertion that the Appellant did not employ the closest prior art compound when testing for unexpected results (Examiner's Answer page 14, second paragraph). The Appellant compared the claimed compounds to trovirdine, which Lind et al. referred to as the "single especially preferred compound". Surely, this means that trovirdine provided better results than those compounds referred to by the Examiner as the closest prior art. Appellant's compounds worked better than trovirdine, and therefore logic would also dictate, based on trovirdine being the single especially preferred compound, that Appellant's compounds worked better than those the Examiner refers to as the "closest prior art". Based on this comparison, the Appellant does not necessarily agree with the Examiner that "absent comparison to the closest prior art, any attempts to illustrate unexpected benefits must fail". Therefore, the Appellant respectfully asserts that unexpected results have been shown between the claimed compounds and those of the prior art.

In view of the above, it is respectfully submitted based on the present facts and applicable law that Appellant's invention as claimed is patentable. It is earnestly requested that the Honorable Board reverse the Examiner's rejection, and that all of the pending claims be allowed.

Respectfully submitted,

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Date: 7/21/04

  
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